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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,559	12/14/2001	Tommy Petrogiannis	9680.188USU1	3770
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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER POWERS, WILLIAM S				
ART UNIT		PAPER NUMBER		
2134				

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/022,559

Applicant(s)

PETROGIANNIS ET AL.

Examiner

William S. Powers

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/14/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>14 July 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-68 have been examined.

Drawings

2. The drawings are objected to under 37 CFR 1.74 for failing to use reference letters or numbers in the description of the figures.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-6, 8-20, 22-27, 29-30, 32-44, 46-50, 52-22 and 57-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,091,835 to Smithies et al (hereto referred to as Smithies).

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As to claims 1, 25 and 49, Smithies teaches:

- a. Using an electronic device to access the Internet (column 11, lines 44-47).
- b. An application verifying the identity of the user through various security measures (column 12, lines 51-54).
- c. Presenting the user with a web-based document (column 20, lines 55-63).
- d. Displaying legal information to user and getting user acknowledgement of said legal information (column 34, lines 8-17).
- e. User signing the web-based document (column 29, lines 46-53).
- f. Getting confirmation of user's intent to sign the web-based document (column 29, lines 46-53).
- g. Generating a transcript object (column 7, lines 10-19) that records all actions taken in the signing of the document and includes the document itself (column 8, lines 15-35).
- h. Making the signed document available to the user (column 40 lines 16-30).

As to claims 2, 30 and 50, Smithies teaches the retrieval of the document from a memory store (column 20, lines 55-63).

As to claims 4, 32 and 52, Smithies teaches transmitting the stored document to the user for viewing while connected to the Internet (column 20, line 55-column 21, line 7).

As to claims 5, 26 and 53, Smithies teaches informing the user of the legal implications of signing the document (column 34, lines 8-18).

As to claims 6, 27 and 54, Smithies teaches the legal implications of the document are legal disclosures (column 13, lines 14-23 and column 22, lines 2-7).

As to claims 8, 29 and 57, Smithies teaches presenting the legal information in dialog boxes (column 34, lines 5-33 and figures 4a-g).

As to claims 9, 10, 33, 34 and 58, Smithies teaches using biometrics (column 12, lines 51-55) and other user specific data (column 33, lines 6-34) to affirm user's identity and attaching it to the document as part of the evidence chain (column 13, lines 42-46) to verify the validity of the signature.

As to claims 11, 35 and 59, Smithies teaches the use of:

- a. A transcript object that is a digital record of the processes (column 12, lines 32-38) that is bound to the document (column 37, lines 25-33).
- b. A private key associated with the document (column 8, lines 38-44).

As to claims 12 and 36, Smithies teaches getting user specific data (column 33, lines 6-34) through the secure system (column 12, lines 51-54).

As to claims 13, 37 and 60, Smithies teaches the use of a transcript object (column 13, lines 14-51).

As to claims 14, 15, 16, 18, 19, 20, 38, 39, 40, 42, 43, 44, 61, 62, 64, 65 and 66, Smithies teaches saving the transcript object (column 44, lines 2-8), the use of a one-way hash created by the transcript generator module (column 14, lines 10-13) and embedding said hash in the transcript object to authenticate signed document(s) and protect them from alteration (column 14, lines 5-21).

As to claims 17, 41 and 63, Smithies teaches the review of the document to be signed and all steps taken in the process of signing the document. The user must affirm all steps to proceed to the actual signing (column 28, line 46-column 29, line 67).

As to claims 22, 46 and 67, Smithies teaches returning the document to the user after signing (column 21 lines 35-38).

As to claims 23 and 47, Smithies teaches making the signed document accessible to the user (column 40 lines 16-30).

As to claims 24, 48 and 68, Smithies teaches that other applications have access to the document (column 40 lines 16-30).

As to claim 55, Smithies teaches displaying legal information (column 24, lines 63-67) on a computer system (column 19, lines 39-43) connected to the Internet (column 12, lines 14-16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 31 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,091,835 to Smithies et al in view of U.S. Patent No. 5,649,186 to Ferguson.

Smithies teaches generating documents for a web browser (column 20, lines 55-63), but does not expressly mention the use of template.

Ferguson teaches the use of templates to generate documents for display on a web browser (column 2, lines 52-60).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to generate the documents for a web browser of Smithies with the template of Ferguson in order to display them in a standardized way.

5. Claims 7, 28 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,091,835 to Smithies et al in view of U.S. Patent No. 6,151,624 to Teare et al. (hereto referred to as Teare).

Smithies teaches the display of legal information concerning the signing of a document (column 34, lines 8-18), but does not expressly state that the legal information is displayed in a web page.

Teare teaches displaying a web page with legal information about an agreement so that the user can accept or decline the agreement (column 16, lines 16-27).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to display the legal information of Smithies in the form of a web page of Teare so that the user can accept or decline the agreement.

6. Claims 21 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,091,835 to Smithies et al in view of U.S. Patent No. 5,646,997 to Barton.

Smithies teaches saving the transcript object (column 44, lines 2-8), using a one-way hash created by the transcript generator module (column 14, lines 10-13) and embedding in the transcript object to authenticate signed document(s) and protect them from alteration (column 14, lines 5-21), but does not expressly state that the hash is embedded in the document.

Barton teaches embedding authentication data within the document allowing a user to determine if the authenticated document has been altered (column 1, lines 6-13).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to generate the hash of the document of Smithies and embed the hash in the actual document of Barton allowing a user to determine if the authenticated document has been altered.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,367,012 to Atkinson et al. teaches document certification and storage.

U.S. Patent No. 6,401,206 to Khan et al. teaches secure access to documents.

U.S. Patent Application Publication No. 2002/0002543 to Spooren et al. teaches the use of templates, digests and legal disclaimers.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers, whose telephone number is (571) 272-8573. The examiner can normally be reached Monday-Thursday from 8 AM – 4:30 PM Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (886) 217-9197 (toll-free).


WSP

7/8/2005


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